

Ferrel et al (U.S. Patent No. 5,860,073 issued January 1999, herein after “Ferrel”). Applicants respectfully traverse the rejections.

The Office Action contends that Shimizu creates a document with the characteristics such as color text, image, and graphic, and indicates how the color text, image, and graphic form are shaped and composed in a manner independent of the type of display and printing devices. The Office Action then asserts that Shimizu teaches shaping and composing the document including the color text, image, and graphic form on the basis of the contents as shown in the indicating step and outputting the composed document including color text, image, and graphic form so that the document can conform to the performance of the display or printing device. The Action further admits that Shimizu does not disclose explicitly determining a set of capabilities of the output device and selecting one of a plurality of style sheets based upon the set of capabilities of the output device as recited in independent claim 35. To overcome this deficiency, the Action contends however, that the format properties of the document of Shimizu are formed based on the capabilities of an output device.

The two steps of creating and indicating in Shimizu are known in the art and used to generate tagged HTML type documents, for example. The composing step is based on the indicating step, which is independent of the type of display and printing device. Shimizu describes an “output control means for outputting the composed document ... so that the document can conform to the performance of the display or printing device” at col. 2, lines 56 – 59. Further, at col. 2, lines 66-67, Shimizu states that these devices (displays and printing devices) “are controlled so that the document can conform to the performance of the devices”.

Among other features, claim 35 calls for determining a set of capabilities of an output device and selecting one of a plurality of style sheets based on upon the set of capabilities of the output device. Contrary to the Action's assertion, Shimizu does not teach or suggest determination of the capabilities of an output device so that a style sheet could be selected so that the document could be formatted. In fact, at col. 3, lines 54-65, Shimizu describes

a previewer for displaying the results of the composition on the multi-window system 6. These results are based on inputs of the DVI file 34, a font data file 33, the image data file 35, and the graphic data file 36, which are all created by the document formatter 11.

That is, in displaying a document on a multi-window system, a previewer is employed for displaying the results of the composing step. The results of the composing step are created by a document formatter that uses a DVI (device independent) file, a font data file an image data file and a graphic data file. In fact, Fig. 6 of Shimizu as described at col. 6, lines 11-20, depicts an intermediate file that contains the results of the composition process. Fig. 3 of Shimizu, described at col. 4, lines 44-53, also shows an intermediate file.

In contrast, the claim 35 invention requires no intermediate file, but rather formats a document for presentation on the output device using a selected style sheet, the style sheet being selected based on a determination of the set of capabilities of an output device. Hence, the claim 35 invention does not rely on a font data file, an image data file and a graphic data file to format the document. Nor does using a font data file, an image data file and a graphic data file to format a document suggest formatting a document using a selected style sheet as recited in claim 35. Nowhere does Shimizu teach or suggest “determining the capabilities of an output device” and selecting a style sheet

“based on the capabilities of the output device” as called for in claim 35. In view of the above, claim 35 and claims 36-41, which ultimately depend from claim 35 are patentably distinct over Shimizu.

To the extent that independent claims 42 and 48 recite features similar to claim 35, they are considered allowable for at least the reasons set forth above. Notably, claim 42 calls for determining a set of capabilities of the output device an output device, and generating a selected style sheet based upon the set of capabilities of the output device, and formatting a document using the selected style sheet. Claim 48 recites interrogating an output device to determine a set of capabilities of the output device and based upon the set of capabilities of the output device, generating a style sheet for formatting a document. Claims 43-47, which ultimately depend from claim 42 and claims 49-53, which ultimately depend from claim 48, are patentable over Shimizu for the same reasons as their ultimate base claim and further in view of the additional novel features recited therein.

It is further respectfully submitted that Ferrel does not overcome the deficiencies of Shimizu. Hence, all of claims 35-53 are patentably distinct from the applied art.

Claims 35 - 53 are further rejected under the judicially created doctrine of double patenting as being unpatentable over Claims 1 – 4, 6 – 11, 14 and 19 of U.S. Patent No. 6,023,714 Hill et al (hereinafter “Hill”). A terminal disclaimer filed herewith in accordance 37 CFR 1.321(c) makes the double patenting rejection of Claims 35 - 53 moot.

In view of the foregoing, it is submitted that claims 35 - 53 are patentable over the art of record and that the application is in condition for allowance. Applicant respectfully

requests the Examiner's reconsideration and withdrawal of the objection and the rejections.

Should the Examiner believe a conference would advance the prosecution of the application, the Examiner is encouraged to telephone the undersigned counsel to arrange such a conference.

Respectfully submitted,

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